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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,048	11/29/2000	Roland Bazin	05725.0800-00	8605
22852 7590 08/07/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER DIXON, ANNETTE FREDRICKA	
			ART UNIT 3771	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/725,048

**Applicant(s)**

BAZIN ET AL.

**Examiner**

Annette F. Dixon

**Art Unit**

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-20, 24-48, 59, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 5, 9, 10, 12-20 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6-8, 11, 25-48, 59, 61 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the Appeal Brief filed on April 27, 2007.

Examiner acknowledges claims 4-20, 24-48, 59, 61, and 63 are pending in this application, with claims 5, 9, 10, 12-20, and 24 having been withdrawn from consideration, claims 4, 11, 25, 38, 46, 48, 59, and 61 having been currently amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4, 6, 7, 11, 25-48, 59, and 60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment may introduce new matter into the disclosure of an application after its filing date. MPEP § 608.04.

Specifically, independent claims 4, 11, 25, 37, 38, 46, 48, and 59 now recite(s) the claim limitation(s) "not a fingerprint or fingerprints" and "does not include a tooth or teeth"; however, the originally filed disclosure does not provide evidence that Applicant possessed the newly claimed invention at the time the application was filed. In fact, the original specification of the instant invention discloses "the external portion could include

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an area of the skin of the individual, at least one stand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual" (Page 4, Lines 10-17). Applicant is reminded that "any negative limitation or exclusionary proviso must have basis in the original disclosure." MPEP §2173.05(i). There is no specific recitation or support for Applicant's invention to not be used for fingerprints or on the tooth in the original disclosure as filed; and therefore the subject matter added to independent claims 4, 11, 25, 37, 38, 46, 48, and 59 is considered new matter and must be cancelled from the claim(s). See *In re Johnson*, 558 F. 2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977); *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984); and *Ex parte Parks*, 30 USPQ2d 1234, 1236 (bd. Pat. App. & Inter. 1993).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 6, 7, 11, 25-48, 59, and 60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. No amendment may introduce new matter into the disclosure of an application after its filing date. MPEP § 608.04.

Specifically, Applicant appears to be claiming multiple embodiments with in one claim. For example: Claim 4 recites a transfer member wherein the transfer member is applied to an external body portion and then later recites a transfer member (assumed

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to be the same transfer member) is applied to an external body portion having a cosmetic product applied thereto. The indefinite nature of the claims lies in that:

1) Applicant discloses the application of a transfer member to an external body portion not having a cosmetic product for a diagnosis of skin conditions (Page 21, Line 15 thru Page 22, Line 2) and discloses the application of a transfer member in combination with a cosmetic product (Page 19, Lines 9-17); however, there is no recitation of both processes utilizes together as Applicant has claimed.

2) Examiner is uncertain if the transfer member of claim 4, line 4 is the same as the transfer member of claim 4, line 14. Within Applicant's disclosure, there is no recitation of a process wherein there are two transfer member utilized.

3) Examiner is uncertain if an additional step is missing or if the limitations of claim 4, lines 13-17 are out of order. Examiner is uncertain where in the process is the cosmetic agent applied to the external body portion. Why is the same or a different transfer member being placed on to the external body portion with or with out a cosmetic agent after the image of the transfer member has been scanned?

Without undue experimentation, Examiner cannot ascertain Applicant's claimed invention. Further, as similar indefinite claim language of claim 4 is perpetuated throughout the remaining independent claims 11, 25, 37, 38, 46, 48, and 59, Examiner requests Applicant carefully review the each of the claims to ensure that only one disclosed embodiment is recited.

***Claim Rejections - 35 USC § 102(b)***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 4, 6, 37, 46-48, 59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,343,536 to Groh.

As to Claims 4 and 6, Groh discloses a process for acquiring scanned image data relating to an external body portion (skin) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of the external body portion (cell and comedone presence, size, etc), and/or

at least one product applied to the external body portion,

wherein the transfer member is placed in contact with an external body portion that is inherently capable of including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product (The system disclosed by Groh is used to detect comedones, which often appear on the face. Any facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would inherently be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data).

As to Claim 48, information regarding the transfer image is collected to form a database (computer storage of binary filtered and normalized data, retrievable therefrom; col. 3, lines 1-32) for use in diagnosis or treatment recommendation determinations. Regarding claim 37, the image can be compared to at least one other image formed from image data stored in and retrievable from an image database (col. 3, lines 1-32).

As to Claim 46, the image is displayed and viewed to analyze the characteristic of the external body portion. Regarding claim 59, the analysis is performed using an image analyzer. Regarding claims 61-62, a "grade" (average number of comedones) that is indicative of at least one condition (accumulation of dirt in sebaceous glands) of the external portion is provided and stored in a database (col. 3, lines 1-32).

***Claim Rejections - 35 USC § 102(e)***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 4, 7, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,533,971 to Stess et al.

As to Claims 4, 7, 8, and 11, Stess et al. disclose a process for acquiring scanned image data relating to an external body portion (torso) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (25/27; col. 5, lines 36-41) in contact with an external portion (torso; in contact via 23) of an individual so as to obtain a transfer image (mold) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (51) to obtain scanned image data for an image representative of at least one characteristic of the external body portion (shape, surface contours, etc), and/or



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at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual (via release layer 23) to produce, on the moldable material, the surface profile of the skin.

Although the transfer member (25/27) is not placed into direct contact with the skin, this is not required by the claim. Furthermore, the release layer can be extremely thin (0.005 inches in thickness), which allows the transfer member to be in sufficient enough contact with the skin to produce the surface profile of the skin on the moldable material.

The transfer member is placed in contact with an external body portion (via release layer 23) that is inherently capable of including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product (The system disclosed by Stess et al. is used to make a mold of the torso. The surface profile of any cosmetic product worn by the patient (i.e., moisturizer, lotion, etc) would inherently be captured when the transfer member is placed in contact with the external portion (via the release layer), and such cosmetic would be part of the scanned image data).

The transfer member is a fabric formed as an article of clothing (shirt).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 25-36 and 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Kvedar (Kvedar, J.C. et al. (1999). Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development. *Telemedicine Journal*, 5(4), 357-366.).

As to Claims 25-36, and 38-45, Groh discloses the previously described process for acquiring scanned image data relating to an external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of the external body portion (cell and comedone presence, size, etc), and/or at least one product applied to the external body portion.

The image scanner is associated with a first computer (col. 2, last line). Groh does not specify transmitting the image to another computer/location for analysis.

Kvedar et al. disclose a process for acquiring scanned image data relating to an external body portion. Kvedar et al. disclose that an image of an external body portion is captured and image data for the image representative of the external body portion is uploaded onto a first computer. The process may further include transferring the scanned image data, via the Internet, to a second computer located at a location remote from the first location (p. 361, for example), so that other users (specialists) can view the images for consultation, to allow remote and repeatable analysis of a condition of the external portion. Kvedar et al. also disclose storing the scanned image data on a data storage medium (computer file), and wherein the transferring may include shipping (via email attachment) the data storage medium to the second location. Once the image data is transferred to the second location, the image is displayed at the second location and viewed to analyze the image characteristics. Kvedar et al. disclose that the scanned image data can be sent to a plurality of locations to be analyzed numerous times.

Kvedar et al. disclose that after the data is sent to a second location and analyzed, a recommendation for treatment can be provided (p. 362, col. 2; "(2)"), wherein the external portion is monitored during treatment ("Routine follow-up calls") and information is provided regarding the effectiveness of the treatment ("assess their progress"). The recommendation is inherently capable of being any recommendation determined by the specialist, including the use of a cosmetic or dermatologic product on the external portion (Kvedar et al. disclose this procedure to be used in treatment of *dermatologic* disorders, which are inherently treatable with *dermatologic* products). The treatment recommendation is provided to the individual and/or treatment provider (p. 362; col. 2)

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via the Internet. Kvedar et al. disclose transferring questionnaire data ("history forms") to the second location, wherein some of the data concerns the condition of the external product and any products applied thereto. The examiner takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to send "at least one of billing information and payment information" to the second location, as is common business practice, in order for the consulting specialist to receive payment for their services. This is well within the performance of a normal business interaction, well known to one of ordinary skill in the art. The examiner also takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to provide product-ordering information along with the treatment recommendation given by the specialist, as is common practice, in order for the patient to obtain the product to be used for treatment. This is well within the performance of a normal patient-client interaction, well known to one of ordinary skill in the art.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 4, 6-7, 11, 25-48, 59, and 60-62 have been considered but are moot in view of the new ground(s) of rejection. In light of

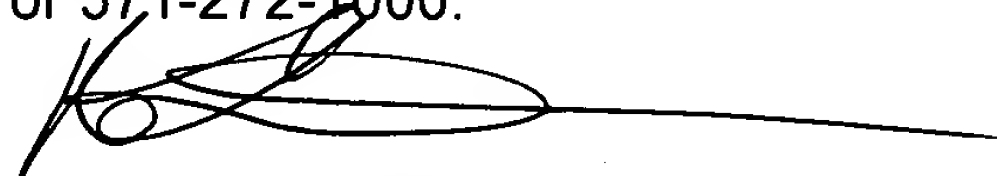
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the new grounds of rejection under 35 U.S.C. §112, the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette F. Dixon whose telephone number is (571) 272-3392. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Annette F Dixon  
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